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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,995	02/09/2001	Ken Kutaragi	SCEI 18.302	5881

7590 12/08/2004

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EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,995

Applicant(s)

KUTARAGI ET AL.

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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NON-FINAL REJECTION

(Paper#12/07/2004)

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful
process, machine, manufacture, or composition of matter or
any new and useful improvement thereof, may obtain a
patent therefore, subject to the conditions and requirements
of this title.

2. Claims 1-3 is rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

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As per claims 1-3, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05(q)).

Also, in this case, the claim language is merely non-functional descriptive.

CLAIM REJECTION — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over McCollom US 2002/0010623; class 705/14, (Jan. 24, 2002) [US f/d: Dec. 1, 1998] (herein referred to as ("McCollom").

As per claim 1, McCollom (§§[0146]; [0147]; [0148]; [0149]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; [0017]; FIG. 14; FIG. 17; FIG. 18; FIG. 19; FIG. 20; FIG. 21; FIG. 22; FIG. 23; FIG. 24; FIG. 25; the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; §§[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; [0059]; and whole document) shows: "An in-contents advertising method, wherein advertisement

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information provided beforehand is included in digital contents activated by a user. . . .”

McCollom lacks an explicit recital of: “determining whether the digital contents have been activated by the user; providing an identifier of the digital contents and an identifier of the user to an advertising information server when the digital contents have been activated; retrieving advertising information from the advertising information server based on the digital contents identifier and the user identifier; and providing the retrieved advertising information for insertion in the digital contents.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of McCollom (¶¶[0146]; [0147]; [0148]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; and [0017]) implicitly shows “determining whether the digital contents have been activated by the user; providing an identifier of the digital contents and an identifier of the user to an advertising information server when the digital contents have been activated; retrieving advertising information from the advertising information server based on the digital contents identifier and the user identifier; and providing the retrieved advertising information for insertion in the digital contents. . . .” and it would have been obvious to modify and interpret the disclosure of McCollom cited above as implicitly showing “determining whether the digital contents have

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been activated by the user; providing an identifier of the digital contents and an identifier of the user to an advertising information server when the digital contents have been activated; retrieving advertising information from the advertising information server based on the digital contents identifier and the user identifier; and providing the retrieved advertising information for insertion in the digital contents. . . .”, because modification and interpretation of the cited disclosure of McCollom would have provided *“the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .”* (see McCollom ¶[0018]), based on the motivation to modify McCollom so as to provide the ability *“for publishing, distributing and redeeming coupons on a network system. . . .”* (see McCollom ¶[0011]).

As per claim 2, McCollom (¶¶[0146]; [0147]; [0148]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; [0017]; FIG. 14; FIG. 17; FIG. 18; FIG. 19; FIG. 20; FIG. 21; FIG. 22; FIG. 23; FIG. 24; FIG. 25; the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; [0059]; and whole document) shows: “An in-contents advertising method for inserting

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advertisement information in digital contents for activation by a user, based on specifications of an advertiser. . . .”

McCollom lacks an explicit recital of: “receiving advertisement structure information for the digital contents from a contents provider at an advertising server; receiving advertiser specified information of the advertiser at the advertising server; preparing the advertisement information based on the advertisement structure information at the advertising server; and providing the advertising information by the advertising server to the contents provider for insertion in the digital contents.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of McCollom ([0146]; [0147]; [0148]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; and [0017]) implicitly shows “receiving advertisement structure information for the digital contents from a contents provider at an advertising server; receiving advertiser specified information of the advertiser at the advertising server; preparing the advertisement information based on the advertisement structure information at the advertising server; and providing the advertising information by the advertising server to the contents provider for insertion in the digital contents. . . .” and it would have been obvious to modify and interpret the disclosure of McCollom cited above as implicitly showing “receiving

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advertisement structure information for the digital contents form a contents provider at an advertising server; receiving advertiser specified information of the advertiser at the advertising server; preparing the advertisement information based on the advertisement structure information at the advertising server; and providing the advertising information by the advertising server to the contents provider for insertion in the digital contents. . . .”, because modification and interpretation of the cited disclosure of McCollom would have provided *“the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .”* (see McCollom ¶[0018]), based on the motivation to modify McCollom so as to provide the ability *“for publishing, distributing and redeeming coupons on a network system. . . .”* (see McCollom ¶[0011]).

As per claim 3, McCollom (¶¶[0146]; [0147]; [0148]; [0149]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; [0017]; FIG. 14; FIG. 17; FIG. 18; FIG. 19; FIG. 20; FIG. 21; FIG. 22; FIG. 23; FIG. 24; FIG. 25; the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; [0059]; and whole document) shows: “An in-contents advertising method for realizing in-contents advertisements in digital contents. . . .”

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McCollom lacks an explicit recital of: “receiving a download request for the digital contents from a user at a contents server; forwarding an identifier of the digital contents and an identifier of the user from the contents server to an advertising information server; and receiving the in-content advertisements from the advertising information server at the contents server for insertion in the digital contents; wherein the in-content advertisements are retrieved from the advertising information server based on the digital contents identifier and the user identifier.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of McCollom (¶¶[0146]; [0147]; [0148]; [0149]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; and [0017]) implicitly shows “receiving a download request for the digital contents from a user at a contents server; forwarding an identifier of the digital contents and an identifier of the user from the contents server to an advertising information server; and receiving the in-content advertisements from the advertising information server at the contents server for insertion in the digital contents; wherein the in-content advertisements are retrieved from the advertising information server based on the digital contents identifier and the user identifier. . . .” and it would have been obvious to modify and interpret the disclosure of McCollom cited above as implicitly showing “receiving a download request for the digital contents from a user at a contents server;

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forwarding an identifier of the digital contents and an identifier of the user from the contents server to an advertising information server; and receiving the in-contents advertisements from the advertising information server at the contents server for insertion in the digital contents; wherein the in-contents advertisements are retrieved from the advertising information server based on the digital contents identifier and the user identifier. . . .”, because modification and interpretation of the cited disclosure of McCollom would have provided *“the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .”* (see McCollom ¶[0018]), based on the motivation to modify McCollom so as to provide the ability *“for publishing, distributing and redeeming coupons on a network system. . . .”* (see McCollom ¶[0011]).

Independent claim 4 is rejected for substantially the same reasons as independent claim 3.

Independent claim 5 is rejected for substantially the same reasons as independent claim 4.

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As per claim 6, McCollom shows the system of claims 4 or 5.

McCollom (FIG. 1; FIG. 2; ¶¶[0054]; [0171]; the ABSTRACT; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; and [0059]) shows: “said digital contents distribution system comprising said first server; said advertisement information providing system comprising said database; and said plurality of user terminal devices; using one, or two or more, of the following means: cable television, broad-band wireless network, and optical fiber network.”

McCollom lacks explicit recitation of “said plurality of user terminal devices; using one, or two or more, of the following means: cable television, broad-band wireless network, and optical fiber network. . . .”, even though the disclosure of McCollom (FIG. 1; FIG. 2; ¶¶[0054]; and [0171]) reasonably and implicitly shows same.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of McCollom at least at (FIG. 1; FIG. 2; ¶¶[0054]; and [0171]) implicitly shows of “said plurality of user terminal devices; using one, or two or more, of the following means: cable television, broad-band wireless network, and optical fiber network. . . .” and it would have been obvious to modify and interpret the disclosure of McCollom cited above as

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implicitly showing of “said plurality of user terminal devices; using one, or two or more, of the following means: cable television, broad-band wireless network, and optical fiber network. . . .”, because modification and interpretation of the cited disclosure of McCollom would have provided “*the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .*” (see McCollom ¶[0018]), based on the motivation to modify McCollom so as to provide the ability “*for publishing, distributing and redeeming coupons on a network system. . . .*” (see McCollom ¶[0011]).

As per claim 7, McCollom shows the system of claims 4 or 5.

McCollom (FIG. 6; FIG. 7; FIG. 12; ¶¶[0066]; [0069]; [0070]; [0079]; [0092]; [0054]; [0171]; the ABSTRACT; FIG. 3A; FIG. 4; FIG. 5; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; and [0059]) implicitly shows: “said advertisement information providing system further comprising means for recording the transmission state of said advertisement in formation, with advertising fees being calculated based on said recording results.”

McCollom lacks explicit recitation of “said advertisement information providing system further comprising means for recording the transmission state of said advertisement in formation, with advertising fees being calculated based on

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said recording results. . . .”, even though the disclosure of McCollom at least at (FIG. 6; FIG. 7; FIG. 12; ¶¶[0066]; [0069]; [0070]; [0079]; [0092]; [0054]; and [0171]) reasonably and implicitly shows same.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of McCollom at least at (FIG. 6; FIG. 7; FIG. 12; ¶¶[0066]; [0069]; [0070]; [0079]; [0092]; [0054]; and [0171]) implicitly shows of “said advertisement information providing system further comprising means for recording the transmission state of said advertisement information, with advertising fees being calculated based on said recording results. . . .” and it would have been obvious to modify and interpret the disclosure of McCollom cited above as implicitly showing of “said advertisement information providing system further comprising means for recording the transmission state of said advertisement information, with advertising fees being calculated based on said recording results. . . .”, because modification and interpretation of the cited disclosure of McCollom would have provided “*the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .*” (see McCollom ¶[0018]), based on the motivation to modify McCollom so as to provide the ability “*for publishing, distributing and redeeming coupons on a network system. . . .*” (see McCollom ¶[0011]).

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As per claim 8, McCollom shows the system of claims 4 or 5.

McCollom (§§[0146]; [0147]; [0148]; [0149]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; [0017]; FIG. 14; FIG. 17; FIG. 18; FIG. 19; FIG. 20; FIG. 21; FIG. 22; FIG. 23; FIG. 24; FIG. 25; the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; §§[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; [0059]; and whole document) implicitly shows: “a contents providing system for creating contents and providing said contents to said digital contents providing system; and an advertisement creating system for creating advertisement information and providing said advertisement information to said advertisement information providing system.”

McCollom lacks an explicit recital of: “a contents providing system for creating contents and providing said contents to said digital contents providing system; and an advertisement creating system for creating advertisement information and providing said advertisement information to said advertisement information providing system.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of McCollom (§§[0146]; [0147]; [0148]; [0149]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016];

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[0017]; FIG. 14; FIG. 17; FIG. 18; FIG. 19; FIG. 20; FIG. 21; FIG. 22; FIG. 23; FIG. 24; FIG. 25; the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; [0059]; and whole document) implicitly shows: “a contents providing system for creating contents and providing said contents to said digital contents providing system; and an advertisement creating system for creating advertisement information and providing said advertisement information to said advertisement information providing system. . . .” and it would have been obvious to modify and interpret the disclosure of McCollom cited above as implicitly showing “a contents providing system for creating contents and providing said contents to said digital contents providing system; and an advertisement creating system for creating advertisement information and providing said advertisement information to said advertisement information providing system. . . .”, because modification and interpretation of the cited disclosure of McCollom would have provided “*the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .*” (see McCollom ¶[0018]), based on the motivation to modify McCollom so as to provide the ability “*for publishing, distributing and redeeming coupons on a network system. . . .*” (see McCollom ¶[0011]).

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As per claim 9, McCollom shows the system of claim 8.

McCollom (FIG. 6; FIG. 7; FIG. 12; ¶¶[0066]; [0069]; [0070]; [0079]; [0092]; [0054]; [0171]; the ABSTRACT; FIG. 3A; FIG. 4; FIG. 5; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; and [0059]) implicitly shows: “said advertisement information providing system comprises means for recording the transmission state of said advertisement information, with advertising fees being calculated based on said recording results. . . .”

McCollom lacks explicit recitation of “the advertiser being billed for said advertising fees from said bank. . . .”

Official Notice is taken that both the concepts and the advantages of “the advertiser being billed for said advertising fees from said bank. . . .” were notoriously well known and expected in the art at the time of the invention because it would have been obvious to modify and interpret the disclosure of McCollom cited above as implicitly showing “the advertiser being billed for said advertising fees from said bank. . . .” because modification and interpretation of the cited disclosure of McCollom would have provided “*the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .*” (see McCollom ¶[0018]), based on the motivation to modify - McCollom so as to provide the ability “*for publishing, distributing and*

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redeeming coupons on a network system. . . .” (see McCollom ¶[0011]).

As per claim 10, McCollom shows the system of claim 8.

McCollom (¶¶[0146]; [0147]; [0148]; [0149]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; [0017]; FIG. 14; FIG. 17; FIG. 18; FIG. 19; FIG. 20; FIG. 21; FIG. 22; FIG. 23; FIG. 24; FIG. 25; the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; [0059]; and whole document) shows: “wherein said advertisement information providing system provides said advertisement creating system with advertisement structure information containing at least portions . . . regarding which advertisement insertion can be made; and wherein said advertisement creating system provides said advertisement information providing system with advertisement information created based on said advertisement structure information and specified information from the advertiser.”

McCollom lacks an explicit recital of: “wherein said advertisement information providing system provides said advertisement creating system with advertisement structure information containing . . . times regarding which advertisement insertion can be made.”

It would have been obvious to one of ordinary skill in the art at the time of

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the invention that the above cited disclosure of McCollom (§§[0070]; and [0079]) shows: “wherein said advertisement information providing system provides said advertisement creating system with advertisement structure information containing . . . times regarding which advertisement insertion can be made. . . .” and it would have been obvious to modify and interpret the disclosure of McCollom cited above as implicitly showing “wherein said advertisement information providing system provides said advertisement creating system with advertisement structure information containing . . . times regarding which advertisement insertion can be made. . . .”, because modification and interpretation of the cited disclosure of McCollom would have provided *“the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .”* (see McCollom §§[0018]), based on the motivation to modify McCollom so as to provide the ability *“for publishing, distributing and redeeming coupons on a network system. . . .”* (see McCollom §§[0011]).

As per claim 11, McCollom shows the system of claims 4 or 5.

McCollom (§§[0146]; [0147]; [0148]; [0149]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; [0017]; FIG. 14; FIG. 17; FIG. 18; FIG. 19; FIG. 20; FIG. 21; FIG. 22; FIG. 23; FIG. 24; FIG. 25; the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG.

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11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; [0059]; and whole document) implicitly shows: “wherein said digital contents data contains advertisement programs, with said advertisement information being set into said digital contents by said advertisement programs.”

McCollom lacks an explicit recital of: “wherein said digital contents data contains advertisement programs, with said advertisement information being set into said digital contents by said advertisement programs. . . .” even though McCollom cited above implicitly shows same.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of McCollom (¶¶[0146]; [0147]; [0148]; [0149]; [0062]; [0086]; [0094]; [0095]; [0098]; [0151]; [0012]; [0016]; [0017]; FIG. 14; FIG. 17; FIG. 18; FIG. 19; FIG. 20; FIG. 21; FIG. 22; FIG. 23; FIG. 24; FIG. 25; the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 15; FIG. 16; ¶¶[0009]; [0118]; [0010]; [0012]; [0013]; [0017]; [0020]; [0056]; [0058]; [0059]; and whole document) implicitly shows: “wherein said digital contents data contains advertisement programs, with said advertisement information being set into said digital contents by said advertisement programs. . . .” and it would have been obvious to modify and interpret the disclosure of McCollom cited

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above as implicitly showing “wherein said digital contents data contains advertisement programs, with said advertisement information being set into said digital contents by said advertisement programs. . . .”, because modification and interpretation of the cited disclosure of McCollom would have provided “*the ability of the consumer to search for merchant coupons or product coupons based on keywords and store name. . . .*” (see McCollom ¶[0018]), based on the motivation to modify McCollom so as to provide the ability “*for publishing, distributing and redeeming coupons on a network system. . . .*” (see McCollom ¶[0011]).

Independent claim 12 is rejected for substantially the same reasons as independent claim 4.

RESPONSE TO ARGUMENTS

4. Applicant's arguments (Amendment paper filed 07/ 01/2004) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons: Applicant's arguments are moot based on new grounds of rejection herein presented by the Examiner.

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CONCLUSION

5. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist

Crystal Park V

2451 Crystal Drive

Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

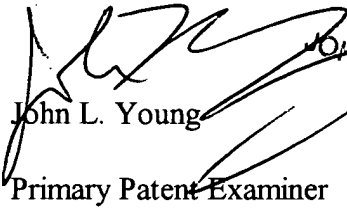
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young
Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

December 7, 2004